

## **REMARKS**

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action. Claims 1-20 are pending in the subject application. Favorable reconsideration in light of the remarks which follow is respectfully requested.

### **Obviousness Rejection**

Claims 1-4, 6, 15, 17, and 18 stand rejected under 35 U.S.C. §103(a) over Lahm (US 6,747,047).

The Office action contends on page 4 that Lahm teaches structurally similar compounds as claimed herein. From this, the Office action concludes that it would have been *prima facie* obvious to one of ordinary skill in the art to obtain compounds within the generic disclosure of the reference, because they are structurally so similar to those claimed herein, and R3 can be phenyl as well, with the reasonable expectation of achieving a successful insecticidal composition, absent evidence to the contrary. It seems that the Office action contends that it would have been obvious to one skilled in the art to change the substituent position of phenyl group of Lahm's compounds from the ortho-position to a meta-position to arrive at the claimed invention.

It is respectfully submitted that there would have been NO motivation for one skilled in the art to modify the compounds of Lahm to arrive at the claimed compounds. There is NO reasonable expectation of achieving a successful insecticidal composition when the structure of the compounds of Lahm is changed. In particular, when the substituent position of phenyl group is changed from the ortho-position to a meta-position in the compounds of Lahm, the modification causes a loss of insecticidal activity.

In this connection, the Examiner's attention is respectfully directed to the enclosed Rule 132 Declaration. The Rule 132 Declaration reports experimental data that indicates that the change of the position of the phenyl group of Lahm's compounds causes a loss of insecticidal activity. Comparative Compound No. 1 has a phenyl group at an ortho-position. See Comparative Example 1-3 at pages 4 and 5

of the Rule 132 Declaration. Comparative Compound No. 2 has a phenyl group at a meta-position. See Comparative Example 2-2 at page 7 of the Rule 132 Declaration. Test Examples 1 and 2 show that Comparative Compound No. 1 has an insecticidal activity, while Comparative Compound No. 2 has no insecticidal activity. See Test Examples 1 and 2 at pages 8 and 9 of the Rule 132 Declaration. While Test Example 1 indicates that Comparative Compound No. 2 shows 20 % mortality at 1,000 pm, one skilled in the art would readily understand that Comparative Compound No. 2 has no insecticidal activity because of the low mortality and the high dose. *Id.* The compounds have no insecticidal activity when only the position of the phenyl group is changed from the ortho-position to the meta-position.

The Rule 132 Declaration shows that there is NO reasonable expectation of similar properties in structurally similar compounds to Lahm. In other words, the Rule 132 Declaration establishes a substantial degree of unpredictability in the art, and thereby sufficiently rebuts the presumption that structurally similar compounds have similar properties. In this connection, MPEP 2144. V. states as follows:

V. < PRESUMPTION OF OBVIOUSNESS BASED ON STRUCTURAL SIMILARITY IS OVERCOME WHERE THERE IS NO REASONABLE EXPECTATION OF SIMILAR PROPERTIES

The presumption of obviousness based on a reference disclosing structurally similar compounds may be overcome where there is evidence showing there is **no reasonable expectation of similar properties in structurally similar compounds**. *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (appellant produced sufficient evidence to establish a substantial degree of **unpredictability** in the pertinent art area, and thereby rebutted the presumption that structurally similar compounds have similar properties); *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). (MPEP 2144.V., emphasis added).

In view of the foregoing, Lahm fails to teach or suggest all the features of claims 1-4, 6, 15, 17, and 18. Consequently, the cited art cannot render the claims obvious. Withdrawal of the rejection is therefore respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. PRZ-33635.

Respectfully submitted,  
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